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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91219754
Party	Defendant Alexso, Inc.
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Date	01/20/2015
Attachments	Alexso - Answer to Notice of Opposition.pdf(54447 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Application Serial No.: 86/242832

Mark: TERO

Filed: April 4, 2014

TARO PHARMACEUTICALS U.S.A., INC.,

Opposer,

v.

ALEXSO, INC.,

Applicant.

Opposition No. 91219754

Application Serial No. 86/242832

ANSWER TO NOTICE OF OPPOSITION

Applicant, Alexso, Inc. ("Applicant"), by and through its undersigned counsel, hereby answers and asserts affirmative defenses to the Notice of Opposition ("Opposition") filed by opposer, Taro Pharmaceuticals U.S.A., Inc. ("Opposer"), as follows:

GENERAL DENIAL

Applicant denies each and every allegation, matter, or thing contained in the Opposition which is not expressly admitted, qualified, or answered herein.

INTRODUCTORY PARAGRAPH

Applicant admits the allegations in the first introductory unnumbered paragraph of the Opposition.

Applicant denies the allegation in the second introductory unnumbered paragraph of the Opposition that Opposer will be damaged by registration of the mark TERO, as shown in Application Serial No. 86/242832 ("Application"). Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the remaining allegations in the second introductory unnumbered paragraph of the Opposition and therefore denies each and

every other allegation set forth therein.

INDIVIDUAL ALLEGATIONS

Applicant responds to the separately numbered paragraphs of the Opposition as follows:

1. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations in paragraph 1 of the Opposition and therefore denies each and every allegation set forth therein.

2. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations in paragraph 2 of the Opposition and therefore denies each and every allegation set forth therein.

3. Applicant admits that Opposer is indicated in the U.S. Patent and Trademark Office databases as the owner of record for trademark Registration No. 2003997 issued on October 1, 1996 for the mark TARO covering “house mark for dermatological preparations; pharmaceutical preparations, namely analgesics, nasal decongestants, antibiotics, antifungal preparations, nasal spray preparations, medical lubricating jelly, medicated skin care preparations, steroid preparations, steroid-antibiotic preparations, topical corticosteroid preparations, anticonvulsant preparations.” Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the remaining allegations in paragraph 3 of the Opposition and therefore denies each and every other allegation set forth therein.

4. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations in paragraph 4 of the Opposition and therefore denies each and every allegation set forth therein.

5. Applicant admits that Opposer is indicated in the U.S. Patent and Trademark Office databases as the owner of record for trademark Registration No. 3017240 (“Registration”) issued on November 22, 2005 for the mark TARO covering “full line of pharmaceutical products intended for the treatment of dermatological, cardiovascular, neurological, hematological, gynecological, allergic and infectious disease conditions.” Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the remaining allegations in

paragraph 5 of the Opposition and therefore denies each and every other allegation set forth therein.

6. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations in paragraph 6 of the Opposition and therefore denies each and every allegation set forth therein.

7. Denied.

8. Applicant admits that the U.S. Patent and Trademark Office databases indicate that Opposer's registration dates and dates of first use for the mark TARO in the U.S. are earlier than any date of first use that may be relied upon by Applicant. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the remaining allegations in paragraph 8 of the Opposition and therefore denies each and every other allegation set forth therein.

9. Denied.

10. Denied.

11. Denied.

12. Denied.

13. Denied.

FIRST AFFIRMATIVE DEFENSE

14. Opposer has not pleaded any law or facts that justify a refusal to register Applicant's mark, and consequently, Opposer has failed to state a claim upon which relief can be granted.

SECOND AFFIRMATIVE DEFENSE

15. Opposer has failed to establish that either Applicant's mark "consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive."

16. Alternatively, Opposer has failed to establish that Opposer used a mark or trade name in the United States that is likely to cause confusion, mistake, or to deceive the public as to an association with Opposer's marks because the goods and/ services used in connection with the parties' respective marks are distinctively different to preclude any finding that consumers would believe that the goods and/or services associated with Applicant's make would fall within the normal fields of expansion for Opposer's alleged goods and/or services.

17. The Trademark Examining Attorney assigned to the Application concluded, on June 18, 2014 and June 20, 2014, that there were no similar registered or pending marks, including Opposer's marks, that would bar registration of Applicant's mark. Accordingly, Opposer has failed to establish that Applicant's mark is likely to cause confusion, mistake, or to deceive the public as to an association with Opposer's marks.

THIRD AFFIRMATIVE DEFENSE

18. Applicant restates paragraphs fifteen (15) through seventeen (17).

19. Opposer has failed to establish that Applicant's mark would falsely suggest a connection between Opposer and Applicant as Applicant's mark is distinctively different than the alleged uses claimed by Opposer.

FOURTH AFFIRMATIVE DEFENSE

20. Opposer's claims are barred, in whole or in part, under principles of laches and/or acquiescence.

FIFTH AFFIRMATIVE DEFENSE

21. Opposer's claims are barred, in whole or in part, under principles of unclean hands.

SIXTH AFFIRMATIVE DEFENSE

22. Applicant reserves the right to rely on such other and further defenses as may be supported by facts to be determined through full and complete discovery and to amend its Answer to assert such defenses.

WHEREFORE, Applicant respectfully requests that the Opposition be denied and/or

dismissed with prejudice, that the registration of Applicant's mark as applied for in the Application be issued, and that Applicant be granted such other and further relief as the Board deems just and proper.

Respectfully submitted,

DATED: January 20, 2015

By: _____

Attorney for Applicant

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CERTIFICATE OF ELECTRONIC MAILING

I hereby certify that the foregoing Answer to Notice of Opposition is being submitted electronically through the Trademark and Trial Appeal Board's ESTTA System on this January 20, 2015.

Wesley W. Lew

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Answer to Notice of Opposition was sent via First-Class Mail, postage prepaid, to Opposer's counsel, Mark B. Harrison, at VENABLE, P.O. Box 34385, Washington, D.C. 20043-9998, on January 20, 2015.

Wesley W. Lew